

Applicant	:	Scott Montgomery
Appl. No.	:	09/990341
Examiner	:	Joshua A. Murdough
Docket No.	:	703602.2

### **Remarks**

All previously pending claims have been cancelled. New claims 85-139 have been added. The applicants respectfully request reconsideration.

#### **Objections and Rejections Regarding the Term “Independent”**

The specification was objected to as failing to provide proper antecedent basis for the requirement in claims 1, 14, 27 and 70 that the indicium and indexing tracking ID be “independent.” The claims were rejected under 35 U.S.C. § 112, 1st paragraph, for failing to comply with the written description requirement with reference to the term “independent.” The claims were rejected under 35 U.S.C. § 112, 2nd paragraph, as being indefinite with reference to the term “independent.”

As the term “independent” does not appear in the currently pending (new) claims, the applicants respectfully submit that this objection and these rejections are moot.

#### **Rejection of Claims Under 35 U.S.C. § 112, Second Paragraph**

In paragraph 8 of the Office Action, claims 1-11 were rejected under 35 U.S.C. section 112 as being incomplete for omitting essential steps, such omission amounting to a gap between the steps of the obtaining, reading or generating of the indexing tracking ID by the postal authority.

In response, the applicants respectfully note that the new claims, such as claim 85, are reciting steps that are performed by a vendor that is not the United States Postal Service (USPS). Therefore, it should not be required to amend the claim to include steps (obtaining, reading or generating of the indexing tracking ID) that could be performed by a different entity, such as the USPS.

Furthermore, the applicants respectfully submit that no step has been omitted that would render the invention as claimed “wholly inoperative.” See, e.g., *Amgen Inc. v. Hoechst Marion Roussel, Inc.*, 314 F.3d 1313, 1338 (Fed. Cir. 2003) (holding that steps are required to be recited in a method claim only if an omission of said step would render the invention wholly

inoperative). The applicants respectfully submit that the steps recited provide for an operative invention, as claimed from the perspective of an entity that is not the USPS.

Claims 1-11, 27-34, 36-38 and 66-84 were rejected as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Specifically, in paragraph 10, claim 1 was rejected for lack of antecedent basis for the limitation “the indexed postage indicium data.” The applicants respectfully submit that this rejection is moot as this limitation does not appear in the new claims.

In paragraph 11, claim 1 was rejected for lack of antecedent basis for the limitation “the centralized postage issuing computer system.” The applicants respectfully submit that this lack of antecedent basis is not present in the new claims and thus this rejection is moot.

#### Rejection of Claims Under 35 U.S.C. § 102 and 103

Claims 27-34, 36-38, 70-78, 81 and 83 were rejected under 35 U.S.C. section 102(b) as being anticipated by U.S. Patent 6,005,945 (hereinafter “Whitehouse”). Claims 1-11, 14-17, 22, 23, 67, 69 and 84 were rejected under 35 U.S.C. section 103(a) as being unpatentable over Whitehouse in view of U.S. Serial No. 2005/0209976 (hereinafter “Bailey”). Claims 79, 80 and 82 were rejected under 35 U.S.C. section 103(a) as being unpatentable over Whitehouse in view of Harmon (“Reading Between the Lines”).

The applicants respectfully submit that new claims 85-139 are patentable over the cited references because those references, either alone or in combination, fail to disclose each limitation of the claims.

#### ***A. Claims 85 and 124***

The method of claim 85 recites:

“receiving, at the vendor-controlled centralized postage issuing computer system, a postage indicium request transmitted from the USPS, wherein the postage indicium request contains the indexing tracking ID; and

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retrieving the data corresponding to the postage indicium from the database based on the indexing tracking ID.”

The applicant’s agree with the Office Action’s acknowledgment that Whitehouse fails to disclose this recited claim language (see Office Action dated March 28, 2008, at page 12, making reference to similar limitations in canceled claim 1).

The applicant’s respectfully submit that Bailey likewise fails to disclose this recited language.

Bailey altogether fails to disclose the receipt, at a vendor-controlled centralized postage issuing system, of a postage indicium request, transmitted from the USPS, containing the indexing tracking ID as claimed. This is because Bailey is almost exclusively directed to remotely located mail terminals (200), which are in essence automated mailboxes. These mailboxes do not issue postage and are located remotely over a geographically disperse area. Thus, they clearly are not a “centralized postage-issuing computer system.”

Furthermore, Bailey fails to disclose the receipt of a postage indicium request transmitted from the USPS containing the indexing tracking ID. This is simply absent from the Bailey reference, as tacitly acknowledged by the Office Action’s failure to cite to any portion of Bailey, including the abstract, that explicitly discloses this. The only data transfer between the USPS and the mailbox (200) comes either by use of a portable data carrier that is held by a postal representative or by way of direct communication with the mailbox (200) when it is located in a “controlled environment” like the post office lobby. However, even if one were to construe this data transfer as the claimed “postage indicium request,” which it clearly is not, Bailey fails to disclose the alleged request including the indexing tracking ID. Indeed, Bailey teaches that the USPS would not even have access to the indexing tracking ID yet, and therefore be unable to include such in the request, since the indexing tracking ID’s of those mail pieces in a particular mail box are not communicated to the USPS until said data transfer takes place.

With regard to the claim language that recites “retrieving the data corresponding to the postage indicium from the database based on the indexing tracking ID,” this is also absent from

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Bailey. Again, this is tacitly acknowledged by the Office Action's failure to cite to any portion of Bailey, including the abstract, that explicitly discloses this.

Finally, the applicant's respectfully disagree with the characterization in the Office Action as to what is shown by Bailey. Contrary to what is stated in the Office Action, Bailey does not show "the postal authority scanning the indexing tracking ID from the mail piece in order to request the indicium data so it can be validated." (See, e.g., Office Action dated March 28, 2008, p. 12.) To validate the indicium data, Bailey teaches scanning the indicium itself ("The input scanner 218 **scans the recipient address 22 and the postal indicia 30 to determine the authenticity of the postal indicia 30.**") (Bailey, para. 26) (emphasis added). Thus, the postage indicium itself is scanned and Bailey does not disclose any further need to request the postage indicium data.

For these foregoing reasons, the applicants respectfully submit that claim 85 is allowable over the cited references.

Likewise, the apparatus claim 124 recites:

"a database management module, operable with the data processing circuitry, programmed to store the data corresponding to the postage indicium within the database, and programmed to retrieve, based on the indexing tracking ID, the data corresponding to the postage indicium from the database in response to a postage indicium request received from the USPS computer system, wherein the postage indicium request comprises the indexing tracking ID."

As set forth above, Bailey and Whitehouse both fail to disclose the receipt of a postage indicium request including the indexing tracking ID from the USPS and both fail to disclose the retrieval of the data corresponding to the postage indicium based on the indexing tracking ID in response to the postage indicium request. Thus, it follows that Bailey and Whitehouse cannot disclose a database management module, operable with the data processing circuitry, that is programmed to do as similarly claimed.

The applicants, therefore, respectfully submit that claim 124 is likewise allowable over the cited references.

***B. Claim 106***

Claim 106 recites:

“transmitting a postage indicium request from the USPS to a vendor-controlled centralized postage-issuing computer system, wherein the request comprises the read indexing tracking ID; and

receiving, at the USPS, data corresponding to the requested postage indicium transmitted from the vendor-controlled centralized postage-issuing computer system.”

The applicants respectfully submit that claim 106 is allowable over Whitehouse and Bailey. Again, the applicant’s agree with the Office Action’s acknowledgment that Whitehouse fails to disclose this recited claim language (see Office Action dated March 28, 2008, p. 13, making reference to similar limitations in cancelled claim 14).

The applicant’s respectfully submit that Bailey likewise fails to disclose this recited language.

As set forth with regard to claim 85, Bailey altogether fails to disclose the receipt, at a vendor-controlled centralized postage issuing system, of a postage indicium request, transmitted from the USPS, containing the indexing tracking ID as claimed. The arguments in support are set forth above and will not be repeated. These arguments likewise support the applicant’s assertion that Bailey altogether fails to disclose “transmitting a postage indicium request from the USPS to a vendor-controlled centralized postage-issuing computer system, wherein the request comprises the read indexing tracking ID.”

Furthermore, the applicants respectfully submit that Bailey altogether fails to disclose “receiving, at the USPS, data corresponding to the requested postage indicium transmitted from the vendor-controlled centralized postage-issuing computer system.” Because Bailey never receives a request for the postage indicium with the indexing tracking ID as claimed, Bailey cannot disclose the receipt of data corresponding to the requested indicium at the USPS.

For these foregoing reasons, the applicants respectfully submit that claim 106 is allowable over the cited references.

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### Conclusion

The applicants respectfully submit that the newly presented independent claims are allowable over the cited references. The applicants respectfully submit that the claims depending therefrom are likewise allowable.

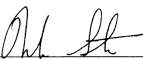
Prompt and favorable action on the merits of the claims is earnestly solicited. Should the Examiner have any questions or comments, the undersigned can be reached at (949) 567-6700.

The Commissioner is authorized to charge any fee which may be required in connection with this Amendment to deposit account No. 15-0665.

Respectfully submitted,

ORRICK, HERRINGTON & SUTCLIFFE LLP

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By:   
Mark Stirrat  
Reg. No. 50,756

Orrick, Herrington & Sutcliffe LLP  
4 Park Plaza, Suite 1600  
Irvine, CA 92614-2558  
Tel. 949-567-6700  
Fax: 949-567-6710